The reply filed on April 22, 2009 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

First, with regard to the IDS submitted on April 22, 2009, a piece of non-patent literature (NPL) was submitted along with the three prior art references (all of them extremely relevant). Its relevance is not explained as required by 37 CFR 1.98(a)(3)(i) nor has applicant provided a translation as required by 37 CFR 1.98(a)(3)(ii) (since English to German translations appear to be readily available to applicant and/or Behr's IP department) nor does it appear on the IDS form itself under the section "NON PATENT LITERATURE DOCUMENTS". It appears to be applicable to claims 1-7. In so far as the examiner can understand this German language NPL reference, it appears to find all of (original?) claims 1-7 as obvious under the German equivalent of 35 USC 103(a), (i.e. "Y" references), over three references (DE 19746185A1, DE 10023847A1 and DE 3916791A1), all of which seem extremely relevant. The NPL document must be properly placed on the IDS form and properly explained/translated so that the examiner can meaningfully understand it. The examiner is very confused because applicant states that the EPO allowed claims similar to these (even though Kawada was initially cited by the EPO as an "X" reference) and the NPL document is, apparently, suggesting claims similar to these are not allowable. Is the NPL document from the EPO or some other patent office? Is there more than one foreign prosecution going on? EP 1633582 B1 should also be placed on the IDS (along with the NPL reference) since

it has been submitted for consideration. Give the examiner some meaningful understanding of what is going on.

Second, with respect to applicant's assertions that the examiner somehow violated some provision of MPEP 2010, the examiner takes great exception to counsel's implication. The examiner never asserted (or even contemplated) that applicant's failure to provide a translation of an older Japanese reference (Kawada) was an act of inequitable conduct. MPEP 2010 pertains to committing fraud/inequitable conduct on the PTO, not to the examiner trying to understand the contents of a foreign reference and how that reference was used against the claims (presumably similar to these) in some foreign prosecution that applicants are very familiar with and to which the examiner has no access. The examiner will not "strike" his statement in the previous office action because it goes to the heart of what the examination process is about. Understanding the prior art and the rejections of sister patent offices is a necessary prerequisite to formulating a rejection or not formulating a rejection in this application. Counsel suggesting that the examiner, in trying to understand the prior art cited by applicant, is engaging in some sort of improper inquiry into issues of inequitable conduct is completely inappropriate.

Applicant states that Behr's IP department "does not a translation". What does that statement (broken English aside) actually mean in the context of the Rule? The Rule (37 CFR 1.98(a)(3)(ii)) states that the translation need only be "readily available"

to Behr's IP department, as the examiner understands it. Is counsel alleging that Behr's IP department does not have a translation of the Kawada reference "readily available" to it, if it asks for one of its translation services? Don't most foreign and domestic IP departments doing overseas filings employ translation services on a continuing basis? For example, Foley and Lardner has obtained translations before of foreign references when this examiner has requested them. As well, the examiner asked, in lieu of a translation, for a paraphrase by counsel of the reference. Apparently counsel understands the Kawada reference well enough to argue (amendment of April 22, 2009, page 9, second paragraph) that it doesn't "show components of an air conditioner that are arranged on a housing cover, as recited in claim 1" The examiner has studied the reference and does not see how counsel could reach such a sweeping and general conclusion. No detailed analysis of precisely what is missing from Kawada or any of the other references in regard to the newly presented/amended claims is made by counsel.

Finally, 37 CFR 1.111 requires applicant not to make general allegations that the claims are patentable without specifically pointing out **how** the language of the claims patentably distinguishes the claims from the references. It is submitted that with respect to all of the references used in the previous rejections, counsel has simply made the most general of allegations that the claimed subject matter is not disclosed without specifically pointing out what claimed elements/limitations are missing from the references or why it would not be possible to combine them as suggested by the examiner. For example, every one of the references has at least one impeller (one of

applicant's claim elements), a fact not acknowledged in counsel's general allegation of patentability. It would therefore appear that counsel must be alleging that some other element (other than an impeller) is missing from the references. Applicant's response must explain to the examiner precisely which claim element or claim elements of each of the references (and especially Kawada) are not disclosed with regard to each of the claims including each of new claims 9-15 as well as amended claims 1-7 and why, if those elements are disclosed, it would not be possible to put them together in the manner described by the examiner, if applicant is contesting that.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John K. Ford/
Primary Examiner, Art Unit 3744